

REMARKS

Claim Rejections under 35 U.S.C. § 103.

An invention is unpatentable under 35 U.S.C. § 103(a) ("Section 103") "if the differences between the subject matter sought to be patented over the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains."

To establish a *prima facie* case of obviousness, three criteria must be met. "First, there must be some suggestion or motivation . . . to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." MPEP § 2142.

"Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *In re John R. Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992). Any such suggestion must be "found in the prior art, and not based on applicant's disclosure." *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991). Indeed, "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." MPEP § 2142.

A "clear and particular" showing of the suggestion to combine is required to support an obviousness rejection under Section 103. *Id.* For the reasons set forth below, Applicant submits that the relevant prior art fails both to teach or suggest all the claim limitations, and to clearly and particularly suggest the combination indicated by the Examiner; thus, Applicant's claims are not obvious in view of the prior art references.

Claims 1, 7-8, 11-12, 22 and 27 stand rejected under Section 103 as unpatentable over the Noni-now.com advertisements (the “Advertisements”) in view of U.S. Pat. No. 6,136,301 to Pelle (“Pelle”). Claims 1 and 27 stand rejected under Section 103 as unpatentable over U.S. Pat. No. 5,676,949 to Bonte (“Bonte”) in view of Wadsworth (WO 01/15537) and further in view of Fisher (Living Better, vol. 1(5)).

In response, Applicant first submits that the Advertisements were improperly cited as prior art due to the Examiner erroneously attributing the 1998-2003 copyright date to the Advertisements for the Tahitian Noni® Lip Balm, Tahitian Noni® Skin Supplement and Tahitian Trim® Plan 40 Body Balance Cream (collectively, the “Noni Products”), rather than to the Noni-now.com website to which it refers. The Advertisements for the Noni Products were added to the website less than one year before the April 20, 2001 filing date of the present application, and thus do not qualify as prior art under Section 103. An affidavit to this effect is available upon request.

As Pelle neither teaches nor suggests a lip treatment comprising *Morinda citrifolia* in any form, Applicant respectfully submits that claims 1, 7-8, 11-12, 22 and 27 are not rendered obvious by Pelle.

Applicant further submits that the remaining properly considered art, namely Bronte, Wadsworth and Fisher, considered cumulatively, do not render claims 1 and 27 obvious as such references neither teach nor suggest the present composition.

Indeed, Applicants’ independent claim 1 recites a lip treatment comprising “a composition for topical application to provide lip care, wherein the composition includes *Morinda citrifolia* seed oil present in an amount between about 0.1-20 percent by weight;

Morinda citrifolia fruit juice present in an amount between about 0.1-50 percent by weight; and at least one of: (i) linoleic acid; and (ii)xeronine.”

In contrast, Bonte teaches a simaba extract used to produce a cosmetic or pharmaceutical composition, wherein such composition may include a mulberry extract.

As noted by the Examiner, Bonte fails to specify or suggest a particular type of mulberry extract. Moreover, Bonte fails to disclose or suggest a particular type of mulberry from which the extract should be derived. As discussed in previous papers submitted in connection with the above-referenced application, multiple species of plants are commonly referred to as “mulberry” plants, despite profound differences in characteristics and qualities specific to each. For example, the white mulberry, otherwise known as *Morus alba*, is classified in a plant family separate and distinct from that of the Indian mulberry, or *Morinda citrifolia*.

The *Morus alba* belongs to the *Moraceae* family of plants, while the *Morinda citrifolia* belongs to the *Rubiaceae* family of plants. Characteristics common to the *Moraceae* family include leaves that are simple, alternate, and rarely opposite, and flowers that are unisexual and minute. In contrast, the *Rubiceae* family features leaves that are simple and usually entire, and are opposite or whorled. Furthermore, *Rubiceae* flowers are typically bisexual.

Based on the divergent classifications and characteristics of the *Morus alba* and *Morinda citrifolia* plants, one skilled in the art would not consider such plants interchangeable or likely to induce similar effects. As Bonte fails to specify a certain type of mulberry plant for use in the claimed composition, and as neither the identity nor the properties of a generic mulberry plant are inherent from designation simply as a mulberry plant, Bonte fails to render the present invention obvious.

Further, Bonte fails to disclose or suggest that more than one type of extract derived from a mulberry plant may be used in combination to obtain or enhance the desired results. Bonte thus further fails to render obvious the present composition as claimed.

Applicants respectfully submit that the inability of the combined references cited by the Examiner to produce the invention as claimed, and the lack of any suggestion or motivation to modify such art to produce Applicants' invention as claimed renders the present invention non-obvious in view of such references. Accordingly, the prior art references cited by the examiner do not anticipate, teach, or render obvious the claims of the present invention as provided herein.


CONCLUSION

Based on the foregoing, Applicant believes that the claims of the present invention are in condition for allowance and respectfully requests the same.

Should the Examiner have any questions, comments, or suggestions in furtherance of the prosecution of this application, the Examiner is invited to initiate a telephone interview with undersigned counsel.

DATED this 11 day of September, 2003.

Respectfully submitted,


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